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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/801,612

03/08/2001

Gerald Francis McBrearty

AUS-2000-0941-US1

5322

7590

10/22/2007

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ART UNIT

PAPER NUMBER

DATE MAILED: 10/22/2007

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/801,612
Filing Date: March 08, 2001
Appellant(s): MCBREARTY ET AL.

For Appellant

EXAMINER'S ANSWER

This is in response to the remand issued from the Board on April 2, 2007 requiring corrections by including the following items: *Evidence Relied Upon*. It noted that another Examiner has been assigned to this application. This Examiner's answer is identical to the previous Examiner's Examiner Answer mailed on July 18, 2006 except for the corrections.

(1) Real Party in Interest

A statement identifying the real party in interest is contained within the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,933,498	Schneck et al.	8-1999
2002/0038296	Margolus et al.	3-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,933,498 to Schneck in view of US Patent Pub. US 2002/0038296 A1 to Margolus.

3. Regarding Claims 1, 8, 15, 16, 23, 30, 31, 38 & 45, Schneck discloses a data processing operation, (Col. 10, lines 14-26), communication network or world wide web communication network, (Col. 14, lines 66-67 & Col. 15, lines 1-13), having stored data in a plurality of data files, (Col. 7, lines 27-36), a system, method and computer program having code recorded on a computer readable medium for protecting said data files from unauthorized users, (Abstract & Col. 7, lines 40-45), comprising:

- means for receiving user requests for access to data files, (Col. 15, lines 19-67; Col. 16, lines 1-59; and Col. 17, lines 54-59); and
- means for determining whether said requests are unauthorized intrusions into said requested data files, (Col. 15, lines 19-67; Col. 16, lines 1-59; and Col. 17, lines 54-59).

4. Though Schneck discloses a tamper detection/reset mechanism and several countermeasures, (including encryption), (Schneck - Col. 7 & Col. 8, lines 1-57), Schneck does not specifically teach a means, responsive to a determination that a request is an unauthorized intrusion, for changing the identification of the requested data files. Margolus teaches a data repository with access-authorization and backup functionalities wherein existing versions of data may be replaced by a new version of the data, (Paragraphs 0011-0032; 0055; 0062 & Claims 1-153). Further, Margolis specifically enumerates that the method may further include a client retrieving a data item by accessing a named object using an access-authorization credential to select the named object, and using the contents of the named object to determine the location of the data item on the storage device, (Paragraph 0011 & Claims 18-26). Moreover, Margolis enumerates a backup of data items stored on the storage device and a keeping of records defining the association between data items and names, (Paragraph 0011 & Claims 18-26).

5. It would have been obvious to one of ordinary skill in the art at the time of invention by Applicant to incorporate the data backup/replacement means of Margolus into the Schneck system for controlling access and distribution of digital property. The motivation to combine is found within Schneck which enumerates a need for a system of distributing data that prevents copying, restricts re-distribution of the data and provides controlled access to the data, (Schneck - Col. 6, lines 43-46). As Margolus specifically teaches a means for copy prevention/re-distribution restriction/access control, use of the same within Schneck would have been obvious for purposes of

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maintaining data integrity and limiting data distribution, (Margolus – paragraph 0009).

Thus, Claims 1, 8, 15, 16, 23, 30, 31, 38 & 45 are found to be unpatentable over the combined teachings of Schneck in view of Margolus.

6. Regarding Claims 2-4, 9-11, 17-19, 24-26, 32-34 & 39-41, the teachings of Schneck in view of Margolus are relied upon for their teachings as disclosed herein. Schneck in view of Margolus further discloses a means for changing the identification of the requested data files, which change the overt identification of the requested files by renaming the files, (per pending Claims 3, 10, 18, 25, 33 & 40), wherein the file renames do not indicate the contents of the renamed files, (per pending Claims 4, 11, 19, 26, 34 & 41), (Margolus – Paragraph 0011 & Claims 18-26). Examiner notes that in creating an access-authorization protected new version of the data item, it would have been obvious to change the overt identification, (name), of the requested file to discourage further non-authorized access. Examiner further notes that the rename of the new file would obviously be unrelated to the file contents for purposes of greater file protection, especially within a tamper detection system wherein the file data had been compromised. Moreover, Margolus teaches the use of the new version contents for location determination, which further implies a covert means of file replacement, identification and access. Thus, Claims 2-4, 9-11, 17-19, 24-26, 32-34 & 39-41 are found to be unpatentable over the combined teachings of Schneck in view of Margolus.

7. Regarding Claims 5, 12, 20, 27, 35 & 42, the teachings of Schneck in view of Margolus are relied upon for their teachings as disclosed herein. Schneck in view of Margolus further discloses a means for changing the identification of the requested data

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files, which change the overt identification of the requested files by renaming the files, wherein the file renames do not indicate the contents of the renamed files, wherein it would have been obvious to move said renamed files into a new directory, (Margolus – Paragraph 0011 & Claims 18-26). Examiner further notes that the renamed files would obviously need to be moved into a new directory for purposes of greater file protection, especially within a tamper detection system wherein the file data had been compromised. Moreover, Margolus teaches the use of the new version contents for location determination, which further implies a covert means of file replacement, identification, location & access. Thus, Claims 5, 12, 20, 27, 35 & 42 are found to be unpatentable over the combined teachings of Schneck in view of Margolus.

8. Regarding Claims 6, 7, 13, 14, 21, 22, 28, 29, 36, 37, 43 & 44, the teachings of Schneck in view of Margolus are relied upon for their teachings as disclosed herein. Schneck in view of Margolus further discloses a means for assigning to each of the renamed files a covert name indicating a covert location in said new directory for each of said renamed files, (per pending Claims 6, 13, 21, 28, 36 & 43) wherein a log references each renamed file to the covert name of the respective file so as to indicate the covert location of said file in said new directory, (per pending Claims 7, 14, 22, 29, 37 & 44), (Margolus – Paragraph 0011 & Claims 18-26). Examiner notes that as Margolus teaches the use of the contents of the new version named object(s) to determine the location of the same on the storage device, that content could obviously include a covert name for greater protection. Examiner further notes that Margolus teaches the keeping of records documenting the association between the data items

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and the names, which records would obviously be kept in some sort of directory with a log for reference, maintenance, access, identification & location convenience.

Moreover, Examiner notes that within a system maintaining several directories, it would have been obvious for each directory to maintain its own log in addition to a separate system-wide log, (or reference to the same), identifying the location of data throughout the system on all directories. Thus, Claims 6, 7, 13, 14, 21, 22, 28, 29, 36, 37, 43 & 44 are found to be unpatentable over the combined teachings of Schneck in view of Margolus.

(10) Response to Argument

10.1 The combined teachings of the Schneck '498 reference and the Margolus '296 reference was proper and in fact renders Appellant's claims 1-45 obvious, (Appeal Brief: p.4)

Appellant argues that the combined teachings of the Schneck and Margolus references do not render Appellant's claimed invention obvious, and Examiner respectfully disagrees.

Appellant indicates that the Schneck reference clearly enumerates "elaborate sets of rules for first determining the type of intrusion, and then providing an expedient for responding to the intrusion", (Appeal Brief – p.4). Appellant then argues that "there is no suggestion whatsoever of changing the identification of the intruded files", (Appeal Brief – p.4).

Next Appellant indicates that the Margolus reference clearly enumerates "changing names when new versions of objects are created", (Appeal Brief – p.5); however, Appellant then argues that "this does not seem to have anything to do with unauthorized intrusions", (Appeal Brief – p.5). Examiner notes that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, as noted by Appellant, Margolus is capable of changing the identification of a file, and thus it meets the claim, especially when viewed in combination with Schneck's system for controlling access to data in accordance with rules enforced via tamper detection.

Examiner points out that it is not enough to assert that either Schneck, on its own, or Margolus, on its own, does not disclose a claimed limitation. Rather, the Applicant must show that the combination of references does not disclose the claimed limitation. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Schneck and Margolus, in combination, do in fact disclose, "responding to an unauthorized intrusion request by changing the identity, (name), of the requested file", wherein the combination would have been proper. Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the

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prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case combination of the Schneck and Margolus references would have been proper, as noted within paragraph 5 of the final office action, which enumerates the following:

It would have been obvious to one of ordinary skill in the art at the time of invention by Applicant to incorporate the data backup/replacement means of Margolus into the Schneck system for controlling access and distribution of digital property. The motivation to combine is found within Schneck which enumerates a need for a system of distributing data that prevents copying, restricts re-distribution of the data and provides controlled access to the data, (Schneck – Col. 6, lines 43–46). As Margolus specifically teaches a means for copy prevention/re-distribution restriction/access control, use of the same within Schneck would have been obvious.

Additionally, In response to Appellant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, (Appeal Brief – p.6), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Again, Examiner notes that it would have been obvious to one of ordinary skill in the art at the time of invention by Applicant to incorporate the data backup/replacement means of Margolus into the Schneck system for controlling access and distribution of digital property. The motivation to combine is found within Schneck which enumerates a need for a system of distributing data that prevents copying, restricts re-distribution of the data and provides controlled access to the data, (Schneck – Col. 6, lines 43-46). As Margolus specifically teaches a means for copy prevention/re-distribution restriction/access control, use of the same within Schneck would have been obvious for purposes of maintaining data integrity and limiting data distribution, (Margolus – paragraph 0009). Thus, Examiner reiterates that the combined teachings of the Schneck and Margolus references would have been proper and would clearly and obviously render Appellant's claims unpatentable.

10.2 Claims 2-4, 9-11, 17-19, 24-26, 32-34 & 39-41 are not in fact more specifically patentable over the combined teachings of Schneck and Margolus. (Appeal Brief – p.7)

Appellant argues that Claims 2-4, 9-11, 17-19, 24-26, 32-34 & 39-41 are patentable over the combined teachings of the Schneck and Margolus references, and Examiner respectfully disagrees.

Appellant distinguishes these claims by noting that they "set forth that the change in identification is achieved by changing the file identifiers or file names in response to an unauthorized intrusion" as opposed to Margolus which "changes identifiers or names

when new versions of the files are created", (Appeal Brief – p. 7). Examiner reiterates those arguments set forth herein above relative to Section 7.1.

10.3 Claims 5, 12, 20, 27, 35 & 42 are not in fact more specifically patentable over the combined teachings of Schneck and Margolus, (Appeal Brief – p.7)

Appellant argues that Claims 5, 12, 20, 27, 35 & 42 are patentable over the combined teachings of the Schneck and Margolus references, and Examiner respectfully disagrees.

Appellant distinguishes these claims by noting that they "set forth a new directory for tracking renamed files", (Appeal Brief – p. 8). Appellant goes on to note that "Margolus does disclose listing of files in directories", (Appeal Brief – p.8); however Appellant disregards the claim distinction and again argues that the combination of references, "do not teach changing a file name or identifier in response to any kind of unauthorized intrusion request", (Appeal Brief – p.8). Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Examiner maintains that these dependant claims are not patentably distinct, and reiterates those arguments set forth herein above relative to Section 7.1.

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10.4 Claims 6, 7, 13, 14, 21, 22, 28, 29, 36, 37, 43 & 44 are not in fact more specifically patentable over the combined teachings of Schneck and Margolus, (Appeal Brief – p.7)

Appellant argues that Claims 6, 7, 13, 14, 21, 22, 28, 29, 36, 37, 43 & 44 are patentable over the combined teachings of the Schneck and Margolus references, and Examiner respectfully disagrees.

Appellant distinguishes these claims by noting that they "set forth assigning a covert name indicating a covert location in a new directory", (Appeal Brief – p. 8). Appellant goes on to note that "Margolus does disclose encryption and decryption", (Appeal Brief – p.8); however Appellant disregards the claim distinction and again argues that the combination of references, "do not teach changing a file name or identifier in response to any kind of unauthorized intrusion request", (Appeal Brief – p.8). Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Examiner maintains that these dependant claims are not patentably distinct, and reiterates those arguments set forth herein above relative to Section 7.1.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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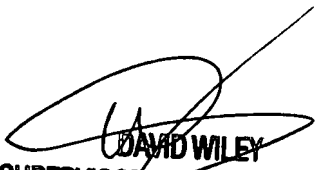
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

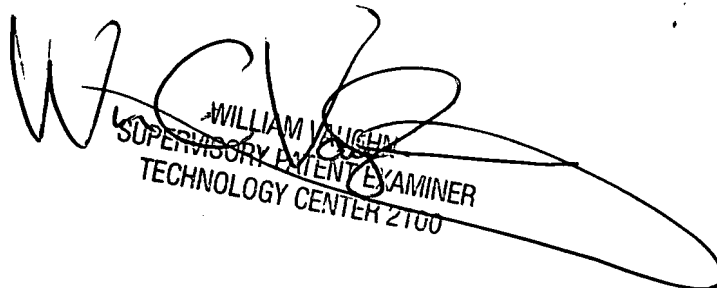


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